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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91214091
Party	Defendant David Reynoso Urzua A/K/A David Reynozo
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Date	12/06/2014
Attachments	Objection to Unconsented Extension of Time to Answer Counterclaim.pdf(37775 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Opposition No. 91214091

Opposition No. 91214147

Villanueva Holding Company LLC v. David Reynozo

**OBJECTION TO UNCONSENTED EXTENSION OF TIME TO ANSWER
COUNTERCLAIM**

PROCEDURAL HISTORY:

Applicant's word mark SN 85807235 published for opposition on Aug. 14, 2013.

Opposer filed for the full 90 days of extension of time in Proceeding 85807235 on September 11, 2013 with the reason being given that: Potential opposer believes that good cause is established for this request by: The potential opposer needs additional time to investigate the claim.

Opposition 91214091 was commenced on December 17, 2013.

Applicant's design mark SN 76713393 published for opposition on Aug. 20, 2013.

Opposer filed for the full 90 days of extension of time in Proceeding on Sep. 11, 2013 with the reason being given that: Potential opposer believes that good cause is established for this request by: The potential opposer needs additional time to investigate the claim.

Opposition 91214147 was commenced on December 23, 2013. The proceedings were consolidated on February 5, 2014.

Both parties consented to 45 days of suspension after the Discovery Conference. This suspension did not result in any productive settlement discussions.

Applicant consented to the 30 day extension on November 3, 2014, one day before the deadline, to allow Opposer more time to answer the counterclaim because Opposer changed attorneys and claimed the desire to have productive settlement discussions.

CURRENT OBJECTION

In the current instance, Opposer, the Defendant in the Counterclaim, had a time to answer that was set to close on December 4, 2014. Again, the day before the deadline on December 3, 2014, Opposer contacted Applicant to ask for consent for another 30 day extension of time.

The consent for the first 30 days seemed reasonable and in good faith because the attorney was new and the new attorney claimed they wanted to settle. However no productive settlement discussions took place until December 3, 2014 and Applicant did not consider the second request for an extension to be in good faith.

TBMP 1207.02 sets out some guidelines regarding requesting extensions of time (for remand) and good cause. “Generally, the later [] that the request [] is filed, the stronger the reason that must be given for good cause to be found.” However in this case, the reasons appear to be getting weaker and the request is still last minute.

Opposer already used up the first consented “We’re new Counsel and we’d like to talk settlement” excuse and Opposer waited 30 days and used the excuse that they have been engaged in an unrelated trial preparation and have not been able to devote their full attention and time to these proceedings. The first extension of time was not used for settlement discussion or for investigating claims but for another matter unrelated to this proceeding. The 'litigation' does not involve Applicant or involve the Board. There appears to be no good faith here. There have been lots of opportunities to investigate claims. It has been over 15 months since Applicant’s marks published for opposition.

As defendant in these oppositions, Applicant has a right to counterclaim but could not counterclaim until Opposer’s pleaded application matured into a registration. While Applicant was the origin for this unavoidable delay in the filing of the counterclaim, Opposer did not dispute this unavoidable delay in the filing as enumerated in <http://ttabvue.uspto.gov/ttabvue/v?pno=91214091&pty=OPP&eno=12>. Opposer also did not use this time to prepare its answer or replace its attorney.

Opposer had considerable time from the filing of the counterclaim on April 15, 2014 until November 4, 2014 (the first deadline) to get their Answer ready, over six months. The Board acknowledged that there had already been considerable time to prepare when they scheduled the time to answer at 20 days after the order rather than the 40 days that is allowed when the need to answer comes as a complete surprise after a Notice of Opposition or Petition to Cancel.

Opposer waited until November 3, 2014 to hire a new attorney. While Opposer’s new attorney may feel rushed, this does not excuse their client’s inaction in replacing the previous

attorney in a timely manner. The client's obligation is not removed by their inaction. See *CTRL Systems Inc. v. Ultraphonics of North America Inc.*, 52 USPQ2d 1300, 1302 (TTAB 1999).

Applicant consented to the first extension because there was good cause, the new attorney was surprised. This additional unconsented request for an extension is just delay and wastes the Board's time and effort as well as Applicant's time. The amount of time since Applicant's marks were published for opposition is not just mere inconvenience, it has been over 15 months. The proceeding itself started almost 12 months ago and the schedule has hardly started. The pendency of this proceeding and Applicant's resulting uncertainty as to its rights in its mark and its registration are not just mere inconvenience. Opposer has revealed no marks being held up as refused when it started these oppositions.

Applicant believes that the Board cannot in this circumstance accept Opposer's explanation that its failures were due to good cause. While being really *busy* may be the truthful reason for the continued delay request, being really busy is not good cause and the delay advantages Opposer while disadvantaging Applicant. Applicant asks the Board to deny the extension or at least restrain Opposer from any further unconsented delays.

Submitted By: /Wendy Peterson/

Date: December 6, 2014

Wendy Peterson, Attorney for Applicant, David Reynozo

CERTIFICATE OF SERVICE

I hereby certify that on December 6, 2014, the foregoing was served upon Villanueva Holding Company LLC's attorney by email as agreed by parties:

trademarks@fleckman.com, raman@fleckman.com,
klbynum@fleckman.com

By: /Wendy Peterson/

Date: December 6, 2014

Wendy Peterson, Attorney for Applicant, David Reynozo